

Appl. No.: 10/528,528
Amdt. dated 08/21/2008
Reply to Office action of 04/21/2008
In conjunction with RCE filing

REMARKS

Applicant acknowledges with appreciation the indication that the objection to the claims and the rejections of the claims under 35 U.S.C. § 112, first and second paragraph are overcome, and the production of references in light of Applicant's request in the response to the previous Official Action. Nevertheless, the Official Action rejects Claims 1 and 4 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,370,514 to Messner (hereinafter the "Messner '514 patent") in view of U.S. Publication 2002/0111879 to Melero et al. (hereinafter the "Melero '879 publication"). Claim 2, 5 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Messner '514 patent and the Melero '879 publication in view of U.S. Publication 2003/0018553 to Lindquist (hereinafter the "Lindquist '553 publication"), and Claim 8 in further view of Official Notice. The Official Action rejects Claims 3, 10, 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over the Messner '514 patent and the Melero '879 publication and further in view of U.S. Patent 7,006,993 to Cheong (hereinafter the "Cheong '993 patent"). The Official Action also rejects Claim 6 under 35 U.S.C. §103(a) as being unpatentable over the Messner '514 patent, the Melero '879 publication and the Lindquist '553 publication and in further view of U.S. Patent Application Publication No. 2002/0087469 to Ganesan et al. (hereinafter the "Ganesan '469 publication").

The Official Action also rejects Claim 7 under 35 U.S.C. §103(a) as being unpatentable over the Messner '514 patent, the Melero '879 publication and the Lindquist '553 publication, in further view of U.S. Patent No. 7,209,889 to Whitfield (hereinafter the "Whitfield '889 publication") and U.S. Patent Application Publication No. 2002/0032605 to Jonas Lee (hereinafter the "Lee '605 publication"). Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over the Messner '514 patent, the Melero '879 publication and the Lindquist '553 publication, and further in view U.S. Publication 2001/0039589 to Aho et al. (hereinafter the "Aho '589 publication"). Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over the Messner '514 patent, the Cheong '993 patent and the Melero '879 publication and further in view of Ganesan '469 publication. Claim 14 is rejected under 35 U.S.C. §103(a) as

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being unpatentable over the Messner '514 patent, the Cheong '993 patent and the Melero '879 publication and further in view of the Aho '589 publication.

The Official Action further rejects Claims 15, 18 and 23 as being unpatentable over the Messner '514 patent. Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over the Messner '514 patent and further in view of Ganesan '469 publication. Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over the Messner '514 patent and further in view of Aho '589 publication. The Official Action rejects Claim 19 under 35 U.S.C. §103(a) as being unpatentable over the Messner '514 patent in view of Official Notice and in further view of U.S. Patent Application Publication No. 2003/0004812 to Kasasaku (hereinafter the "Kasasaku '812 publication"). Finally, the Official Action rejects Claims 20-22 under 35 U.S.C. §103(a) as being unpatentable over the Messner '514 patent in view of Official Notice and in further view of the '889 Whitfield publication.

Claims 1, 5, 7, 10, and 15 have been amended to clarify the claimed invention and further patentably distinguish the claimed invention. Claim 24 has been added. Support for the amendments and the new claim can be found in the specification and in the figures. No new matter has been added by way of these amendments. In view of the amendments to the claims and the remarks presented herein, Applicant respectfully requests reconsideration of the present application and prompt allowance of all the pending claims.

Independent claims 1, 5, 10, and 15 are directed to a system and methods for managing sales, gifting, and usage of electronic gift certificates according to requests by a communication terminal through a network. More particularly, independent Claim 1 is directed to a gift certificate service system for managing sales, gifting, and usage of electronic gift certificates comprising a gift certificate service server, a gift certificate database, accessed by the gift certificate service server, and a network server.

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By contrast, the Messner '514 patent is directed to a method for marketing and redeeming vouchers for use in online purchases that includes a voucher server for processing the related transactions. In this regard, the voucher server maintains a database of participating merchants, virtual malls, and outstanding purchased vouchers. As such, a purchaser may purchase a voucher that may be delivered to a recipient. However, the information of the voucher is not stored on the voucher server until the voucher is successfully delivered to a recipient designated by the purchaser.

Initially, Applicant notes that the gift certificate database of the claimed invention is patentably distinct from the database maintained by the voucher server. In this regard, and as mentioned above, the Messner '514 patent discloses that the voucher purchased by a purchaser is only stored in the voucher server if the voucher has been successfully delivered to a recipient designated by the purchaser. See col. 9, lines 51-56 of the Messner '514 patent. By contrast, the claimed invention recites a gift certificate database that stores the gift certificate information, prior to the gift certificate being delivered to a recipient. Further Applicant respectfully submits that the patentable features of the gift certificate database that form a basis for patentability are set forth in the claims, contrary to the assertion on page 18 of the Official Action. Nevertheless, independent Claim 1 has been amended to clarify and recite that the gift certificate is stored in the gift certificate database prior to transferring the gift certificate to a transferee. Independent claims 5, 10, and 15 have been similarly.

In this regard, and as an example, Independent Claim 5 is directed to an electronic gift certificate circulating method for a gift certificate service system including a gift certificate database and a gift certificate service server to manage sales of the electronic gift certificates. Claim 5 includes the step of storing the issued gift certificate information in the gift certificate database after the step of issuing the electronic gift certificate to the user. Further, amended Claim 5 also recites that the gift certificate database stores electronic gift certificate information prior to transferring the gift certificate to a transferee. As such, the gift certificate database stores the information of the issued gift certificate regardless of whether the gift certificate has been

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transferred to a transferee. Independent Claims 1 and 15 recite features of the gift certificate database similar to the ones discussed above with respect to independent Claim 5.

As a further example, independent Claim 10 is directed to an electronic gift certificate circulating method for a gift certificate service system including a gift certificate database and a gift certificate service server to manage gifting of the electronic gift certificates. Claim 10 includes the step of inquiring within the gift certificate database of an existence state of the gift certificate possessed by the user, and determining the existence state before the step of transmitting the gift certificate selected by the user to the transferee. Amended Claim 10 further recites that the transferring step is based upon the determined existence of the gift certificate. In other words, the method of Claim 10 is made to inquire that the user has previously bought a gift certificate, or hence that the gift certificate information is stored in the gift certificate database, before permitting the transfer to the transferee. As such, the information of the gift certificate being transmitted to the transferee already exists and is stored in the gift certificate database before being transmitted or successfully delivered to a transferee.

By contrast, the Messner '514 patent discloses that the information of the voucher purchased by a purchaser is only stored in the voucher server if the voucher has been successfully delivered to a recipient. Accordingly, the Messner '514 patent fails to teach, suggest, or render obvious a database that stores issued gift certificates information in a gift certificate database, as provided in the claimed invention. Moreover, none of the additionally cited references overcome the deficiencies of the Messner '514 patent with respect to the gift certificate database of the claimed invention, teach or suggest a gift certificate database of the claimed invention, and are not cited for such. For at least the foregoing reasons, Applicant respectfully submits that the Messner '514 patent and the additionally cited references, taken individually or in various combinations with each other, fail to teach, suggest, or render obvious independent Claims 1, 5, 10, and 15, and the claims dependent therefrom, namely Claims 2-4, 6-9, 11-14, 16-23, respectively.

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Nevertheless and notwithstanding these patentable features of the gift certificate database recited in the claims, independent Claim 1 has been further amended to recite that the electronic gift certificate is a multimedia message including barcode image data and that the electronic gift certificate information stored by the gift certificate database includes at least one of gifting history of the gift certificates and usage history of the gift certificates. Independent Claims 5, 10, and 15 have been similarly amended.

In this regard, the Messner '514 patent fails to teach or suggest the features of amended independent Claims 1, 5, 10, and 15, namely that the electronic gift certificate is a multimedia message including barcode image data and that the gift certificate database stores gift certificate information including at least one of gifting history of the gift certificates and usage history of the gift certificates. Initially, Applicant notes that, on page 9 for example, the Official Action acknowledges that the Messner '514 patent fails to teach or suggest message formats including SMS (short message service) format or a MMS (multimedia message service) format, and as such, the Messner '514 patent cannot teach or suggest an electronic gift certificate that is a multimedia message including barcode image data. Instead, the Official Action relies on the Aho '589 publication for the sole purpose of disclosing message formats including SMS (short message service) format or a MMS (multimedia message service) format. However, the Aho '589 publication fails to teach or suggest an electronic gift certificate or a message format including barcode image data, and therefore cannot teach or suggest an electronic gift certificate that is a multimedia message including barcode image data.

Further, although the Messner '514 patent discloses that the voucher information is stored in the database if the voucher has been successfully delivered to a recipient, the Messner '514 patent fails to teach or suggest that the voucher server stores gifting history and usage history of the gift certificates. At most, the Messner '514 patent only discloses that the balance of the gift certificate is reduced by the purchase amount. Moreover, none of the additionally cited references overcome the deficiencies of the Messner '514 patent and the Aho '589 publication with respect the amended independent claims in that none of the cited references teach or suggest

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the features of amended independent Claims 1, 5, 10, and 15, namely that the electronic gift certificate is a multimedia message including barcode image data and that the gift certificate database stores gift certificate information including at least one of gifting history of the gift certificates and usage history of the gift certificates, and are not cited for such. For at least the foregoing reasons, Applicant respectfully submits that the Messner '514 patent and the additionally cited references, taken individually or in various combinations with each other, fail to teach, suggest, or render obvious independent Claims 1, 5, 10, and 15, and the claims dependent therefrom, namely Claims 2-4, 6-9, 11-14, 16-23, respectively.

Further, with respect to the rejection of dependent Claim 7, Applicant initially notes that Claim 7 depends from and includes the features of independent Claim 5 which is patentably distinct from the cited references for at least the reasons discussed above. Moreover, Claim 7 has been amended to recite that that the purchase request includes information on a category of the gift certificates desired by the user, a price, and a number of gift certificates. Applicant respectfully submits that none of the cited references teach or suggest that a purchase request includes a number of gift certificates. As such, the rejection of Claim 7 is also overcome for this additional reason.

Moreover, Claim 24 has been added and Applicant initially notes that Claim 24 depends from and includes the features of independent Claim 1 which is patentably distinct from the cited references for at least the reasons discussed above. Further, Claim 24 recites that the history of the gift certificate is classified by types, users, and prices of the gift certificates. As discussed above, the Messner '514 patent fails to teach or suggest that the voucher server stores gifting history of the gift certificates and usage history of the gift certificates. Further, none of the additionally cited references overcome the deficiencies of the Messner '514 patent with respect to the claimed invention in that none of the cited references teach or suggest the features of amended that the gift certificate database stores gift certificate information including at least one of gifting history of the gift certificates and usage history of the gift certificates, and purchase history of the user, and are not cited for such. Therefore, it necessarily follows that the Messner

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'514 patent and the additionally cited references also fail to teach or suggest that the history of the gift certificate is classified by types, users, and prices of the gift certificates. As such, Claim 24 is patentably distinct from the Messner '514 patent and the additionally cited references and is therefore allowable.

Accordingly, Applicant respectfully submits that the rejection of independent Claims 1, 5, 10, and 15, and the claims dependent therefrom, namely Claims 2-4, 6-9, 11-14, 16-23, respectively, under 35 U.S.C. §103(a) is overcome and that Claims 1-24 are allowable.


CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the claims of the present application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of present application.

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It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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